

**REMARKS**

Applicants have amended the title to emphasize the novelty of invention

Claims 2-29 are pending in the application. Careful consideration has been given to the Office Action of October 18, 2006 and it is respectfully submitted that after the amendatory  
5 action, which has been taken, place the application into condition of allowance.

**The Objection to The Specification And The Claims Rejection Under § U.S.C. 112.**

Office action is rejecting claims 2-28 under 35 U.S.C. 112 as failing to comply with the written description requirement:

10 Office Action States:

*Regarding Claim 28, the limitation of "unscripted two-way communication" is not supported by the instant specification.*

-As a remedy applicants have amended claim 28 and removed the word "unscripted"

Office Action States:

15 *Regarding Claim 12, the limitation of "geographical location information that can be obscured by said supply client computer with predetermined accuracy defining possible area in which the supply client computer is located; and said possible area is much smaller than the search area" is not supported by the specification...*

Office Action notices that on page 4, lines 25-28 recites that user might want their "location  
20 unclear"

Office Action is credited to point out that specification does not define possible area and the possible area much smaller than search area.

Possible accuracy adjustment area being bigger than the search area would possibly take supply client out of the map. Therefore being able to show supply client on the map, when  
25 location is obscured, there is no other possibility for accuracy adjustment but being smaller than search area. Therefore claiming accuracy adjustment being much smaller than the search is a moot point and can be removed.

-As a remedy claim 12 has been amended to allowable condition.

**Office Action States:**

*Regarding claim 29, "said location information" lacks proper antecedent basis. Is "said location information" referring to "supply-side geographic information"*

-As a remedy claim 29 has been cancelled.

- 5 Accordingly applicants submit that after amending the claims the claims are in par with description and request withdrawal of this objection.

**The Rejection Of Claim 28 On Tanaka and Obradovich Is Overcome**

- 10 Office Action rejected claim 28 On Tanaka (US 6,819,919) and Obradovich (US 6,525,768). Claim 28 has been amended to define patentability over these referencies and any combination of thereof. Applicants request reconsideration of the rejection for the following reasons:

- 15 Unsugesssted Combination: There is no justification, in Tanaka and Obradovich or in any other prior art separate from applicant's disclosure, which suggests that these references be combined, much less be combined in the manner proposed.

- 20 References Are Individually Complete: Each reference is complete and functional in itself, so there would be no reason to use parts from or add or substitute parts to any reference.

References Take Different Approaches: The references take mutually exclusive paths and reach different solutions to a similar problem. Since they teach away from each other, it would not be logical to combine them.

- 25 Tanaka facilitating communication between unknown persons without knowing them or their location, Obradovich tracking location of friends knowing them and their locations –to be considered argument

Inoperative Combination: If combined , the referencies would produce an inoperative combination.

5 **The References And Differences Of The Present Invention Thereover**

Prior to discussing the claims and the above 4 points applicants will first discuss the referencies and the general novelty of the present invention and it's unobviousness over the referencies

10 Tanaka's invention US Patent 6,819,919 facilitates communication between requester and owner's of profiles returned by a server. *Information is gathered from a central database that stores user profiles and real-time locations of system users. Mobile users can request information on nearby users by submitting a request from a mobile telephone*  
The request has user's location, obtained from GPS. The server searches the profile database  
15 for nearby users based on requester's location, locations of other users of the system and optional parameters specified in the request. Search results are returned to the requester.  
(abstract)

Tanaka's system does not broadcast user's location information to the requester,  
20 Therefore Tanaka's invention is unsuitable for fast trade, dispatching and emergency situations.

Tanaka uses location information merely on the server to to restrict, make boundaries, for the search area. However he does not suggestst using the information to locate persons, but states using secure server "The system supports secure contact, in which no personal contact  
25 information is disclosed"

Tanaka does not have a map-feature on his mobile device to show locations. Additionally Tanaka's carefully advancing contact protocol makes contacting a seller or buyer difficult and awkward.

Present invention enables immediate pinpointing on the users map and immediate response with direct communication means without “handshaking” protocol.

5      Obradovich US Patent 6,525,768 describes a mobile GPS enabled PCD with a display to show maps. User can dynamically track a third party by requesting GPS updates. Request are received and approved or denied by third user. Third party can send updates via communication links, which can be cellular phone, satellite or radio communication link.

10     However, Obradovich does employ a server, therefore he can only take one contact at time to a third party. Since he needs to take contact before being able to plot and interpolate GPS data, his device is limited only to known people.

15     Even if Obradovich’s device could be combined to and built to work with Tanaka it would be remarkably slower than present invention, since contacts have to be established on a one-to-one bases Additionally the search would be limited only to previously known users.

20     Present invention provides universal internet based search engine, which is capable by one phonecall to download thousands or previously unknown users location and profiles, offering great advantage over Obradowich in speed, funtionality and convenience and power consumption.

25     There is no justification, in Tanaka and Obradovich or in any other prior art separate from applicant’s disclosure, which suggests that these references be combined, much less be combined in the manner proposed.

United States Court of Appeals For Federal Circuit, January 26, 1988 decided:

*To reach a proper conclusion under 35 U.S.C.S. § 103, the decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when*

*the invention was unknown and just before it was made. In light of all the evidence, the decisionmaker must then determine whether the claimed invention as a whole would have been obvious at that time to that person (In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).*

5

Present invention claims priority from provisional application 60/226,956 filed August 22, 2000, at the advent of mobile GPS phones. Just before the invention was made, Benefon had announced:

*13 October 1999 15:12*

10 *Press Release -For release October 8th, 1999 at 10.00 Finnish Summer Time (0700 UTC)*

*BENEFON INTRODUCES WORLD'S FIRST GSM+GPS PERSONAL NAVIGATION  
PHONE, THE BENEFON ESC!*

<http://www.prnewswire.co.uk/cgi/news/release?id=35933> (copy attached)

15 Applicants respectfully asks examiner to step back to the time when invention was made and reconsider his position.

20

Tanaka Uses Location Information to Restrict Search Area, Not To Locate Users by Another User

25 Tanaka describes:

*"The server searches the profile database for nearby users based on requester's location, locations of other users of the system and optional parameters specified in the request."*  
(abstract)

Office Action is suggesting on page 4-5 that since Tanaka's invention relates to a personal matching/meeting service (Col 1, Lines 16-25) wherein Tanaka teaches that person A and Person B can choose to initiate face-to-face contact (Col 4, Lines 40-41). If Geographical location information of both Person A and Person B are provided to the host server, it would  
5 have been obvious to one of ordinary skill in the art to use the location information, not only for the purpose of matching, but also for the purpose of allowing the persons to meet each other."

Indeed Tanaka's invention relates to a matching and personal meeting service where Person  
10 A and person B eventually may choose to initiate face to face contact. This can only happens after a communication protocol, which Tanaka describes as follows:

- 1) Users B establish profiles (PublicImage) in database (*Col 3, Lines 19-20*)
- 2) User A searches profiles by submitting request (query) to server (*Col 3, Line 67 – Col 4, Lines 1-6*)
- 15 3) User A receives reply from server containing accessible portions of Public Image matching the query (*Col. 4, Lines 17-19*).
- 4) User A views the PublicImages and decides whether or not to request the owner of specific PublicImage. After decision... (*Col 4, Lines 22-24*)
- 5) As initial request to contact, Person A sends his/her PublicImage to recipient, Person B  
20 (*Col 4, Lines 24-27*).
- 6) Person B access person A's PublicImage (*Col 4, Lines 27-29*) and makes a decision weather contact person A or not, if B Choose to accept request
- 7) Person B contacts person A by preferred anonymous method, email or Caller-ID Blocked Phone Call.
- 25 8) After correspondence, consequently Person A and Person B can choose to initiate face-to-face contact.

Geographical locations of both persons are known to the host server, however, no location information has been given out of from server to locate the persons.

After talking on a phone and deciding to initiate face-to-face contact the meeting might  
5 happen. However, conventionally people want to meet on a commonly known, secure public place where both can arrive without the help of a map without giving out their telephone number or address at first.

As a matter of fact, Tanaka is describing a protocol, which has been used for centuries by  
10 people to contact each other's by using local newspaper personals. People have posted personal advertisement into which other people have responded same way as in above described protocol. [PublicImage, Profile =Add, Host Server- Database=Newspaper, Publisher] Correspondence protocol has been taken place by letter or phone. Advertiser's addresses, geographical location information, have been known by publisher, but not given  
15 out.

Or Match have been able to be made by computer as Tanaka is describes

*"The User reviews the search results via the MU and interacts with the search results much in the same way www users interact with result from search engines." (Col 4, Lines 20-23).*

20

America Online -AOL search engine in the 90's allowed its members search user profiles of AOL-Personals, by e.g. gender and age and Public Image profile by using search words.

Searches were performed by Personal Computer (PC) within predetermined area. Searches were restricted by user withing any desired location e.g. town or zip code around the user.

25 AOL has customer's addresses, i.e. geographical location information, for billing purposes, but is not using them or giving them out "for the purpose of allowing the persons to meet each other as suggested in the office action.

The Only difference between Tanaka's invention and prior-art AOL service is that Tanaka is using mobile terminals and derives geographic positioning information from a Positioning System, instead of e.g. zip-code.

On AOL and in Tanaka's Patent description persons are using geographic location  
5 information as a selection criteria, not as a criteria now to navigate to a face-to-face contact

Even if facilitated meeting of persons would have been technically possible it has not been suggested.

Therefore Office Action is highly speculating that it would have been obvious to combine  
10 Tanaka and Obradovich's to use the location information on a server to locate users and pinpoint them on the display map of a mobile device. Referenced Prior Art patents do not teach, nor suggest the proposed combination. As a matter of fact Tanaka is concerned about security and highly unmotivated to disclose any personal location or contact information of any of the users.

15 *Tanaka continues: The system supports secure contact, in which no personal contact information is disclosed. For example, an email message can be sent through the server without revealing either person's private email address or location. (Col.4. Lines 34-38)*

Tanaka expressly states that no personal contact information is disclosed. Therefore  
20 Examiners suggestion that it would have obvious and motivated to disclose current location to another, unknown user is respectfully reversed.

### **Combining Tanaka with Obradovich Results Awkwardly Functioning Device**

25 The Prior Art Must Suggest The Desirability of The claimed Invention

With regard to the proposed combination of Tanaka and Obradovich, it is validly know that in order for any prior-art references themselves to be validly combined for use in prior-art §



103 rejection, the references themselves (or some other prior art) must suggest that they be combined. E.G. as was stated in In re Sernaker U.S.P.Q. 1,6(C.A.F.C. 1983

5 *"Prior-Art References in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."*

*That the suggestion to combine the references should not come from applicant was forcefully stated In –Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193. 199 (CAFC 1983):*

10

*It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references combining the right references In the right way to archive the result of the claims in suit [here the claims pending). Monday morning quarterbacking is quite Improper when resolving the question of non-obviousness in a court of law (here the PTO)*

15 It was further stated In Uniroyal, Inc. v. Rudkin-Willey Corp., 5U.S.P.Q.2d 1434 (C.A.F.C. 1988).

*"[w]here prior-art references require selective combination by the court to render obvious a subsequent invention. There must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in that prior-art must suggest the desirability and thus the obviousness of making the combination." [Emphasis supplied]*

20

In line with these decisions. the Board stated In Ex parte Levengood. 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

25 *'In order to establish a prima facie case of obviousness. It Is necessary for the examiner to present evidence, preferably In the form of some teaching, suggestion, incentive or inference In the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been able to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention ... that which is*

*within the capabilities of one skilled in the art is not anonymous with obviousness. ... That one can reconstruct and/or explain the theoretical mechanism of an invention.*

*Invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to*

5 *have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark*

*Office that it can satisfy the burden of establishing a Prima Facie case of obviousness only by showing some objective teaching in either the prior-art, or knowledge generally available*

*to one of ordinary skill in the art. That 'would lead' that individual to combine the relevant*

10 *teachings of the references.' ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.*"

Prior Art does not suggest desirability to search, match, locate, pinpoint on a map and

15 communicate with previously unknown clients. In the present case there is no reason given in

the last O.A. to support the proposed combination other than the statement 'both references

uses GSP enabled communication device with a display". However the fact that both

references teach a search method is not sufficient to gratuitously and selectively substitute

parts of one reference for a part of another reference in order to meet applicants' novel

20 claimed combination.

As stated in the above Levengood case,

*"That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness*

25 *conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.."*

Applicant therefore submits that combining Tanaka and Obradovich is not legally Justified and Is therefore Improper. Thus they submit that the rejection on these references is also Improper and should be withdrawn.

5 Applicants respectfully request. if the claims are again rejected upon any combination of references, that the Examiner include an explanation in accordance with M.P.E.P. § 706.02. *Ex Parte Clapp* 27 U.S.P.Q. 972 (P.O.B.A. 1985). And *Ex Parte Levengood*, *supra* a factual basis to support his conclusion that it would have been obvious

10 Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

15

Fact That References Can Be Combined Or Modified Is Not Sufficient To Establish Prima Facie Obviousness

20 The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)  
Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed.  
25 Cir. 1992)

Based on the facts that there is no justification, in Tanaka and Obradovich or in any other prior art separate from applicant's disclosure, which suggests that these references combined,

much less be combined in the manner proposed, examiner is respectfully solicited to reconsider his position.

Fact That The Claimed Invention Is Within The Capabilities of One Of Ordinary Skill In The Art Is Not Sufficient By Itself To Establish Prima Facie Obviousness

5

*A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).*

10

Neither Tanaka nor Obradowich is presenting a reason why to combine teaching of the references.

15

**If combined , the referencies would produce an inoperative combination.**

The present invention is Internet based mobile-to-mobile search engine utilizing positioning system to pinpoint Supply and Demand on a map, enabling fast electronic trade of any good or service, taxi dispatching, immediate dating, fast police and ambulance service by using pre-programmed selection (Fig 5a) or search words.

20

*[0077] Ambulance and police that are connected to a service have continuous search open for alarms. Whenever alarm is sent from a telephone on their predetermined search area the map shows the location of the caller related to their location similar way than taxi driver gets customers location enabling a fast response to the alarm. Emergency personal can contact the person immediately by using the phone as taxi driver can contact his/her customer without the dispatcher.*

25

Prior-art does not teach host server providing at least location information. Prior-art uses positioning information merely on the server as a parameter to restrict search area.

However prior-art does not employ, teach, suggest nor show motivation to give out location information on a server assisting mobile Demand to meet mobile Supply or even less mobile Supply to meet mobile Demand.

5 Technology behind the only common element "GSP enabled communication device with a display" is different. While present invention and prior art reference uses multiple simultaneous connection storing data on a server, Obradovich uses one-to-one connection over cellular telephone network and storing information in individual mobile terminal.

10 Even if Tanaka's invention would be able to be combined with Obradovich's teaching with a map and ability to locate known friend on a map, the combination would not work because Obradovich requires that telephone numbers of searchable third party users were known to user.

user have to request location from third parties and in order to do so would have to contact all  
15 searchable third party users individually to obtain their location.

This would be inoperable combination in situations where user needs immediate attention.  
New Novel Physical Features of claim 38 Produce New and Unexpected Results and Hence  
Are Unobvious And Patentable Over Tanaka and Obradovich

20 Also Applicants submit that the new novel features of their invention of claim 28 are also unobvious and patentable under &103 since they produce new and unexpected results over Tanaka and Obradovich, or any combination thereof.

Present invention enables taxi-dispatching without dispatchers. Calling taxi by using taxi  
25 profile or dedicated taxi number will send message and location to taxi drivers around user to locate the fare and pick him/her up

New feature is also to be able to respond emergency calls immediately. In current 911 dispatcher system user has to call a dispatcher who would then allocate police or ambulance for user. In the rural area it might take a long time to get help.

In the presented system anybody can volunteer to get emergency messages, see emergency  
5 location on the map and arrive in time to help.

Additionally system user have ability to find out "who is looking for me" and which is not suggested in prior-art documents.

10 **Conclusion**

For all the above reasons applicants submit that the specification and claims are now in proper form and that the claims all define patentably over the prior art. Therefore they submit that this application is now in condition for allowance, which action they respectfully solicit.

15 **Conditional Request For Constructive Assistance**

Applicants have amended the specification and claims of this application so that they are proper, definite, and define novel structure which is also unobvious. If, for any reason this application are not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. §  
20 706.03(d) and §707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

*tel. 646 321 9134*

***Certificate of Mailing***

I hereby certify that this correspondence and the documents referred to therein and the referenced attachments, if any, are being deposited with the United States Postal Service as  
5 First Class Mail with in an envelope addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, with sufficient postage on a date appearing below. Respectfully submitted

10 April 18, 2007

A handwritten signature in black ink, appearing to read 'Veijo Tuoriniemi', is written over a horizontal line.

Veijo Tuoriniemi

15 Inventor

## News Release

Friday 8 October 1999, 7:00 GMT

Friday 8 October 1999

TECHNOLOGY

Benefon

### **BENEFON INTRODUCES WORLD'S FIRST GSM+GPS PERSONAL NAVIGATION PHONE, THE BENEFON ESC!**

Salo, Finland - On Saturday, October 9, at Telecom 99 in Geneve, Benefon will introduce a revolutionary new wireless instrument one never gets lost with. Featuring electronic maps, a GPS navigator, a personal organiser and an advanced dual-band GSM phone, the Benefon Esc! personal navigation phone is the complete survival pack of the contemporary nomad. Yet it is extremely small (129 x 49 x 23 mm) and weighs only 150 grams.

Benefon Esc! is designed and engineered for the great outdoors. It is water and shock resistant, with stainless steel reinforced casing. Benefon Esc!'s design draws inspiration from the Finnish nature and the pure elements of water, rock, light and metal.

Benefon Esc! has a big screen to display maps and other navigational information, to guide oneself from one place to another, whether globetrotting, backpacking, biking or boating. Several maps, from around Europe, can be downloaded to Benefon Esc!, using any PC with a web browser. Touring maps, city maps, topographical maps and nautical charts are all supported.

Benefon Esc! has a state-of-the art twelve-channel GPS receiver and an integral high-gain flip antenna. The product enables graphical and numeric display of navigational information like location, speed, heading and world time. Additional functionality includes waypoints, routes, trip odometer and NMEA 0183 interface.

Friend Find is an exclusive feature of Benefon Esc! personal navigation phone. It tracks other users of Benefon Esc!, locates them on the map, and even guides the user to them. Benefon Esc! also has an emergency button, sending an SOS message with user's location.

The dualband GSM 900/1800 phone has unparalleled reception and RF technology for optimal connection and the widest possible coverage. This can be further extended by using the optional high-gain cross-country antenna. The standby operating time is up to ten days, and Enhanced Full Rate voice quality and vibrating alert come as standard features. Benefon Esc! is also a personal organiser and communication center. It comes complete with a phone book, calendar, appointment manager and alarm clock with snooze. Access to email and the web is enabled through the in-built 14.4 kbps GSM data and fax modem. Writing text messages and notes is made fast and easy by the big screen and predictive text input.

"The Benefon Esc! personal navigation phone further strengthens Benefon's position as the leading designer and manufacturer for innovative, high-quality wireless instruments. The product is a result of great and intense teamwork at Benefon, and it has been met with tremendous enthusiasm wherever initially presented", said Jukka Nieminen, Director Product Marketing.

Benefon Esc! will be available during the first half of year 2000.

Additional information and photography about Benefon Esc! is available at [www.benefon.com](http://www.benefon.com)

Benefon is a leader in innovative wireless communication instruments, renown for their unparalleled performance, professional quality and Finnish design. Since 1988, Benefon has designed and manufactured products in Salo, the wireless industry centre of Finland.

*Distributed by PR Newswire on behalf of Benefon*

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